

REMARKS

In the present amendment, claims 12-15 have been amended and claims 1-11 have been cancelled. Accordingly, claims 12-15 remain pending in the application with claim 12 being independent.

Applicants note that claim 12 has been amended by adding the features of now cancelled claim 1. Furthermore, claim 12 has been even further clarified to address the indefiniteness rejection by reciting "1 to 75 parts by weight of a resolvent with respect to 100 parts per weight of said pressure sensitive adhesive."

No new matter has been added.

Restriction Requirement

Applicants note that withdrawn claim 9 has been canceled. Applicants preserve the right to pursue the subject matter of the canceled claim 9 in a divisional application.

Applicants further preserve the right to proceed with the non-elected subject matter of now cancelled claims 1-8, 10 and 11 in a divisional application.

Information Disclosure Statement

The Office Action lined through the references JP 2753800 and JP 3260765 cited on Applicants' Form PTO-1449 filed with an IDS on May 19, 2006, stating that "they were not provided or were not provided in English."

Applicants note that 37 C.F.R. § 1.98 provides that: (a) any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section. Section (a)(1) requires a list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application

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publications must be listed in a section separately from citations of other documents. Each page of the list must include: (i) The application number of the application in which the information disclosure statement is being submitted; (ii) A column that provides a space, next to each document to be considered, for the Examiner's initials; and (iii) A heading that clearly indicates that the list is an information disclosure statement.

Section (a)(2) requires a legible copy of: (i) each foreign patent; (ii) each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office; (iii) for each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and (iv) all other information or that portion which caused it to be listed.

Section (a)(3) requires (i) a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from Applicant's specification or incorporated therein.

MPEP 609.04(a) states that "[t]he concise explanation may be either separate from the specification or part of the specification. If the concise explanation is part of the specification, the IDS listing should include the page(s) or line(s) numbers where the concise explanation is located in the specification." It further states that "[t]he requirement for a concise explanation of relevance is limited to information that is not in the English language . . . Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an 'X', 'Y', or 'A' indication on a search report."

Applicants note that JP 2753800 and JP 3260765 both are discussed in the present specification, and the IDS specifically indicated (as set forth in 609.04(a)) the page of the specification where the relevance of these documents was discussed. Applicants further note that WO 9714411, a family member of JP 3260765, has been submitted together with an English language machine translation in a Supplemental Information Disclosure Statement filed on July 7, 2006. Furthermore, Applicants note that JP 2753800 (B2) was cited as corresponding to JP-A- 285854, which has been considered by the Examiner.

Applicants further note that MPEP 609 provides:

Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. There is no requirement that the information must be prior art references in order to be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

(Emphasis added.) Applicants note that the IDS was compliant, for all of the reasons explained above, and that the Examiner's consideration of the submitted documents is required. The Examiner's initials on a Form PTO-1449 do not mean that the Examiner reads the Japanese language, but rather, that she has considered the documents to the extent required, based upon the information provided by Applicants, which met the requirements. As the rules state, the Examiner's consideration is shown by initials in the required space on the Form PTO-1449, and comments such as "abstract only" or "to the extent written in English" are not within the Patent Office's authorization. ("The examiner will indicate that the non-English language information has been considered in the same manner as consideration is indicated for information submitted in English. The examiner should not require that a translation be filed by applicant. The examiner should not make any comment such as that the non-English language information has only been considered to the extent understood, since this fact is inherent." MPEP 609.05(b), emphasis added.)

Applicants provide herewith a Form PTO-1449 in which the lined-out documents
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JP 2753800 and JP 3260765 have been re-listed. As can be also followed up in public PAIR, copies of JP 2753800 and JP 3260765 have been previously submitted. Applicants further submit English language Abstracts of JP 2753800 and JP 3260765. Furthermore, U.S. Patent No. 5,638,472 has been listed as an English family member of JP 2753800. Applicants believe that no fee should be necessary for consideration of the cited documents. However, should a fee deemed to be required, the Office is authorized to charge such fee to Deposit Account No. 19-0089.

Specification

The Office Action asserts that the title of the invention is not adequately descriptive and requires a more descriptive title that includes a reference to tulobuterol.

In response, Applicants note that the title has been amended to recite an "Adhesive Skin Patch for Percutaneous Absorption of Tulobuterol." Accordingly, withdrawal of the objection to the title is respectfully requested.

The Office Action further objects to the specification, stating that "the claim for domestic priority to PCT/JP04/17305 has not properly made." The Office Action asserts that should Applicants wish to claim the benefit of a prior application filed under 35 U.S.C. § 119(e), 120, 121, or 365(c), a specific reference to the prior-filed application must be included in the first sentence of the specification following the title, or presented in an application data sheet.

Applicants respectfully disagree. Applicants note that this application is a national stage of PCT/JP04/17305, filed on November 19, 2004. According to MPEP § 1893.03(c), Applicants are not required to amend the specification in the manner suggested by the Office Action. Applicants submit that priority has been properly claimed under 35 U.S.C. § 371, and there should be no further requirements.

Rejections under 35 U.S.C. § 112, second paragraph

The Office Action rejects claims 1-8 and 10-15 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Office Action asserts that it is not clear to which standard the recitation of the term “parts” is referring.

Applicants note that claims 1-8, 10 and 11 have been cancelled, and claim 12 has been amended by adding the features of now canceled independent claim 1. Claim 12 has been further amended to recite that “1 to 75 parts by weight of a resolvent with respect to 100 parts per weight of said pressure sensitive adhesive.”

In view of the amendments of claim 12 and cancellation of claims 1-8, 10 and 11, withdrawal of the indefiniteness rejections is respectfully requested.

Rejections under 35 U.S.C. § 103(a)

The Office Action rejects claims 1-8 and 10-15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bracht (WO 00/64418 and referring to family member U.S. 6,689,379, because WO 00/64418 is in German), hereinafter “Bracht,” in view of Nakano et al. (US 6,117,447), hereinafter “Nakano.”

The Office Action asserts that Bracht teaches all elements of the presently claimed invention, but admits that “Bracht does not teach the instantly elected species alkyl(meth)acrylate.” The Office Action concludes that Nakano remedies the deficiency of Bracht by teaching an alkyl(meth)acrylate as employed by the presently claimed invention, and that it would have been obvious to replace the pressure sensitive adhesive polymer of Bracht with the adhesive disclosed in Nakano.

Applicants respectfully traverse the rejection. Applicants note that in an attempt to advance prosecution of the present application and without expressing agreement with or acquiescence to the rejection, claims 1-8, 10, and 11 have been canceled, and claim 12 has been amended by adding the features of now canceled claim 1.

Applicants note that both Bracht and Nakano fail to disclose or suggest a pressure-sensitive adhesive as recited in present claims 12-15, i.e., a “copolymer obtained by copolymerization of monomers containing 2-ethylhexyl(meth)acrylate and an alkyl(meth)acrylate whose alkyl group is linear and has 6 to 20 carbon atoms.” Applicants respectfully disagree with the Examiner’s assertion relating to Nakano’s teaching at, column 2, lines 11-30; column 3, lines 50-53; and column 4, lines 6-11. Nakano teaches in these sections a copolymer that comprises a) an alkyl(meth)acrylate, wherein the alkyl group has 4 to 12 carbon atoms in the range of 60 to 98 wt% and b) a functional monomer having at least one unsaturated double bond in a molecule and a functional group on a side chain in the range of 2 to 40 wt%. Nakano does not teach that two types of monomers falling under the definition of monomer a) should be combined to a copolymer.

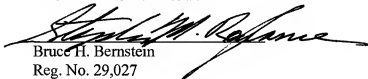
Applicants further note that with respect to the functional monomer b) Nakano does not contemplate the use of an alkyl(meth)acrylate whose alkyl group is linear and has 6 to 20 carbon atoms. Rather, Nakano teaches away from the selection of a such a monomer by teaching only examples in which the alkyl group of alkyl (meth)acrylate has been modified with a linear or branched alkoxy having 1 to 4 carbon atoms (see Nakano, column 3, line 63 to Nakano column 4, line 5).

In view of the foregoing and the cancelation of claims 1-8, 10, and 11, because the combination of Bracht and Nakano does not teach or suggest all elements of present claims 12-15, withdrawal of the obviousness rejection over Bracht and Nakano is respectfully requested.

CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the objections and rejections of record, and allow each of the pending claims. Applicants therefore respectfully request that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Respectfully submitted,
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Enclosures: Form PTO-1449 and English language Abstracts of JP2753800 and JP3260765

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